

REMARKS

As a preliminary matter, Applicants note that the Office has not properly recorded the priority claim to U.S. Provisional Application 60/198,819, which is noted in an Amendment with a Request for Continued Examination filed on February 8, 2007. Applicants respectfully request that the Examiner acknowledge the priority claim and make the necessary correction to the record.

Also as a preliminary matter, Applicants thank the Examiner for withdrawing the rejection under 35 U.S.C. § 102(e).

In this Reply, Applicants have amended 4, 6, 8, 14, 55, 63, 66, 68, 74, 115, 121, 126-142, 177-181, and 183-184, and cancelled claims 60, 120, and 182. No new matter has been introduced. Claims 4-20, 55-59, 61-64, 66-80, 115-119, 121-122, 126-142, 177-181, and 183-184 are currently pending.

In the Office Action, the Examiner rejected claims 4, 6, 14, 55, and 177 under 35 U.S.C. § 112, second paragraph as being indefinite; rejected claims 126, 130, 136, and 177 under 35 U.S.C. § 112, second paragraph for reciting "program code for," rejected claims 128, 130, 136, and 177 under 35 U.S.C. § 101 as being directed to non-statutory subject matter; and rejected claims 4-20, 55-64, 66-80, 115-122, 126-142, and 177-184 under 35 U.S.C. § 103(a) as being unpatentably over U.S. Patent No. 6,654,779 to Tsuei ("*Tsuei*") in view of U.S. Patent No. 5,581,749 to Hossain et al. ("*Hossain*"). For the reasons that follow, Applicants respectfully traverse these rejections.

I. Section 112, Second Paragraph Rejections

A. Claims 4, 6, 14, 55, and 177

In the Office Action ("OA"), the Examiner rejected claims 4, 6, 14, 55, and 177 under 35 U.S.C. § 112, second paragraph as being indefinite because they allegedly constitute hybrid claims. (OA at 2). On their face, each of claims 4, 6, 14, 55, and 177 is a method claim. The Examiner contends, however, that the recitation of "a [forwarding] service unit" could indicate a product claim, and thus, the Examiner interprets these claims as directed to both a product and a process. (OA at 2). Applicants respectfully disagree with the Examiner's reasoning and interpretation.

Specifically, as the Examiner correctly identifies, claims 4, 6, 14, 55, and 177 each recites "a method for providing an electronic change of physical address service," and thus these claims are clearly process claims.¹ With respect to the recitation of "a [forward] service unit," Applicants submit that one of ordinary skill in the art would not interpret this recitation to be an intent to claim a product claim, because the claims clearly indicate that the forwarding service unit is a device or a component that may be used to carry out certain steps of the claimed method. Moreover, the specification makes clear that this is the case. (*See, e.g.*, Spec. at paras. 0034-0035; Figs. 6 and 7).

For at least the foregoing reasons, Applicants request the withdrawal of the 35 U.S. C. § 112, ¶ 2 rejection of claims 4, 6, 14, 55, and 177.

¹ The Examiner states that the recitation of "a method . . ." reasonably indicates an express intent to claim a product claim, and the recitation of "a service unit" reasonably indicates an express intent to claim a process claim. Applicants believe this to be a typographical error and that the Examiner meant to associate the recitation of "a method . . ." with a process claim, and the recitation of "a service unit" with a product claim.

B. Claims 126, 130, 136, and 177

In the Office Action, the Examiner rejected claims 126, 130, 136, and 177 under 35 U.S.C. § 112, second paragraph for reciting "program code for," and argued that these claimed elements can allegedly be regarded as intended use. (OA at 3). Each of claims 126, 130, 136, and 177 has been amended to remove the phrase "program code for," rendering this rejection moot.

For at least the foregoing reasons, Applicants request the withdrawal of the 35 U.S.C. § 112, ¶ 2 rejection of claims 126, 130, 136, and 177.

II. Section 101 Rejection

In the Office Action, the Examiner rejected claims 128, 130, 136, and 177 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicants thank the Examiner for advising Applicants with amendments that would overcome this rejection. Applicants have followed the Examiner's suggestion and amended claims 128, 130, 136, and 177, and thus, request the withdrawal of the 35 U.S.C. § 101 rejection of claims 128, 130, 136, and 177.

III. Section 103(a) Rejection

Applicants respectfully traverse the Section 103(a) rejection of claims 4-20, 55-59, 61-64, 66-80, 115-119, 121-122, 126-142, 177-181, and 183-184 because *Tsuei* and *Hossain*, taken alone or in combination, fail to disclose or suggest every claim element in these claims. Applicants respectfully submit that the Office Action failed to provide rationales to support a conclusion of obviousness in this case because the Office Action did not properly ascertain the scope and content of the cited prior art, and because there are significant differences between the teachings of the cited references

and the claims, as a whole. M.P.E.P. § 2141 (II, III) ("The gap between the prior art and the claimed invention may not be 'so great as to render the [claim] nonobvious to one reasonably skilled in the art.'") (internal citations omitted).

For example, independent claim 4, as amended, recites a method for providing an electronic change of physical address service from an old physical address of a customer to a new physical address of the customer, comprising, *inter alia*, "providing a service for reestablishing contact with a second customer who has changed an address from a second old physical address to a second new physical address," "receiving a request from the customer having the second old physical address of the second customer to re-establishing contact with the second customer," "determining the second new physical address for the second customer," and "providing the new physical address of the customer to the second customer at the second new physical address."

The above-identified features were included in previously presented claim 60, which is now cancelled. With respect to these features, the Office Action merely states that these features "do not further limit the inventive concept disclose[d] in claim 4," and that they "are clearly taught in Tsuei's disclosure." (OA at 7.) Applicants note that this same conclusory rejection is included in the Final Office Action dated November 5, 2008 at page 4. In a response dated September 30, 2009 (hereby incorporated by reference), Applicants explained in detail why this rejection is improper and inadequate. Applicants maintain that this rejection is improper for at least the reasons stated in the response dated September 30, 2009 at pages 27 -28. In addition, Applicants respectfully request that the Examiner provide the exact citations of cited references

supporting these rejections in the next Office Action, so that Applicants may have a fair chance to respond to them.

Contrary to the Office Action, Applicants submit that *Tsuei* does not clearly teach the above-recited features. For example, *Tsuei* does not teach "receiving a request from the customer having the second old physical address of the second customer to re-establishing contact with the second customer," "providing the new physical address of the customer to the second customer at the second new physical address," as recited in claim 4.

First, as explained in Applicants' previously filed responses, *Tsuei* is concerned solely with e-mails, and does not teach a system capable of handling physical mail that is being sent to a physical address (such as, e.g., a person's home address). Second, as recited in claim 4, both the customer sending the request for reestablishing contact and the second customer have changed their addresses, thus, claim 4 is directed to a process that involves two changes of addresses. However, *Tsuei* only deals with a single change of address, and does not provide any teachings regarding processing of a second change of address. Specifically, *Tsuei* is only directed to a system for processing an intended recipient's change of address, and is not concerned with a sender's change of address. Thus, *Tsuei* fails to disclose at least the above-identified combination of features.

Hossain, which is relied on for its alleged disclosure of handling physical mails, do not remedy the deficiencies of *Tsuei*. Applicants respectfully submit that because *Tsuei* and *Hossain* fail to disclose or suggest at least the above-identified claim features, the Office Action did not properly ascertain the scope and content of the

references and the combination of those references cannot result in the invention of amended claim 4. Moreover, the undisclosed features represent significant differences between the teachings of the references and claim 4, as a whole, which render claim 4 nonobvious. Although of different scope, amended independent claims 6, 8, 14, 55, 63, 66, 68, 74, 115, 126, 128, 130, 136, and 177 recite features similar to those of claim 4. Consequently, *Tsuei* and *Hossain* do not render independent claims 6, 8, 14, 55, 63, 66, 68, 74, 115, 126, 128, 130, 136, and 177 obvious, and these claims are also allowable over the references of record.

Dependent claims 5, 7, 9, 10-13, 15-20, 56-59, 61-62, 64, 67, 69-73, 75-80, 116-119, 121-122, 127, 129, 131-135, 137-142, 178-181, and 183-184 incorporate the features of the independent claims from which they depend. Consequently, *Tsuei* and *Hossain* do not render these dependent claims obvious, and they are allowable over the references of record at least by virtue of their dependence from allowable independent claims. Dependent claims 5, 7, 9, 10-13, 15-20, 56-59, 61-62, 64, 67, 69-73, 75-80, 116-119, 121-122, 127, 129, 131-135, 137-142, 178-181, and 183-184 are also allowable by virtue of reciting additional features not taught nor suggested by *Tsuei* and/or *Hossain*.

For at least the foregoing reasons, Applicants request the withdrawal of the 35 U.S. C. § 103(a) rejections.

IV. Conclusion

The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statements are

identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 25, 2010

By:



Judy W. Chung
Reg. No. 61,612